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EXAMINER	
LASTRA, DANIEL	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS G. LAPCEVIC

Appeal 2009-000955
Application 09/598,506
Technology Center 3600

Decided: August 26, 2009

Before: MURRIEL E. CRAWFORD, ANTON W. FETTING, and BIBHU R. MOHANTY, *Administrative Patent Judges.*

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection of claims 1 to 19. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellant invented a computer-assisted method of establishing a brand presence in a remote facility. (Spec. 3).

Claim 1 under appeal reads as follows:

> 1. A computer assisted method of establishing a brand presence in a remote facility, comprising:
>
> accessing, by remote facility personnel, a central network computer housed in a central facility having a playlist that controls the playback of audio and video broadcasting within the remote facility, the playlist comprising free entertainment and advertisement content;
>
> entering on the playlist, by remote facility personnel, identifiers of advertisement content related to the remote facility; and
>
> the central computer network accessing the playlist entered by the remote facility personnel and pushing to the remote facility the playlist.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Dejaeger	US 6,456,981 B1	Sep. 24, 2002
Stern	US 6,553,404 B2	Apr. 22, 2003

The Examiner rejected claims 1 to 19 under 35 U.S.C. § 103(a) as being unpatentable over Dejaeger in view of Stern.[1]

[1]The rejection of claims 1, 8, and 14 under 35 U.S.C. § 112, first paragraph was not included in the rejections listed in the Answer. We therefore conclude that the rejection was obviated by the amendment filed by the Appellant on October 19, 2006 and is not before us on appeal.

ISSUE

Has Appellant shown that the Examiner erred in rejecting the claims because the prior art does not disclose a method that includes the step of entering on the playlist, by remote facility personnel, identifiers of advertisement content related to the remote facility?

FINDINGS OF FACT

Dejaeger discloses a method and apparatus for displaying a customized advertising message with a retail terminal (col. 1, ll. 1 to 4). A central server 42 at the remote facility is in communication with each of the retail terminals 12 (col. 5, ll. 58 to 60). The central server 42 has a mass storage device 46 associated therewith which includes a user profile database 50 which includes retail information associated with a particular customer (col. 6, ll. 10 to 14). The mass storage device 46 also stores a promotion database 52 which includes electronic files which may be utilized to display video and/or audio messages on the retail terminals 12 (col. 7, ll. 14 to 20). The promotion database may include an electronic file which is associated with an advertisement which is generated from the information in the user profile (col. 12, ll. 54 to 58). An external network system 56 may be located in a centralized office associated with the retailer. The central network system 56 provides a centralized source for electronically updating the various databases associated with the central server 42 (col. 8, ll. 1 to 7).

PRINCIPLES OF LAW

An invention is not patentable under 35 U.S.C. § 103 if it is obvious. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 427 (2007). The facts

underlying an obviousness inquiry include: Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. *Graham v. John Deere Co.,* 383 U.S. 1, 17-18 (1966). In addressing the findings of fact, "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR* at 416. As explained in *KSR*:

> If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida* and *Anderson's-Black Rock* are illustrative - a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

KSR at 417.

A prior art reference is analyzed from the vantage point of all that it teaches one of ordinary skill in the art. *In re Lemelson*, 397 F.2d 1006, 1009 (CCPA 1968) ("The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all

they contain."). Furthermore, "[a] person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR* at 421.

On appeal, Applicants bear the burden of showing that the Examiner has not established a legally sufficient basis for combining the teachings of the prior art. Applicants may sustain their burden by showing that where the Examiner relies on a combination of disclosures, the Examiner failed to provide sufficient evidence to show that one having ordinary skill in the art would have done what Applicants did. *United States v. Adams*, 383 U.S. 39, 52 (1966).

ANALYSIS

We will not sustain the rejection of the Examiner. Independent claims 1, 8, and 14 recite a method that includes a step whereby the remote facility personnel can alter the playlist that is stored at the central network computer. We agree with the Appellant that Dejaeger does not disclose remote facility personnel entering identifiers of advertisement on the playlist. In Dejaeger, the external network system 56 at the centralized office updates the data of the server 42. We do not agree with the Examiner that column 15, lines 5 to 16 disclose this feature (Ans. 3). What is disclosed in this portion of the reference is that the server 42 at the remote facility can determine how many advertisements to display. Dejaeger does not disclose that the remote facility personnel can access the playlist *on the external network 56 at the centralized office* and select advertisements to display at the consumer terminals. To the contrary, Dejaeger discloses that the external network at the central office updates the database of the server 42 not the other way around.

CONCLUSION OF LAW

On the record before us, Appellant has established that the Examiner erred in rejecting claims 1 to 19 under 35 U.S.C. § 103 as being unpatentable over Dejaeger in view of Stern.

DECISION

The Examiner's decision is reversed.

REVERSED

hh

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